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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Yu-Wen CHEN, et al.

Serial No.: 10/056,361

Group No.: 3729

Filed: January 25, 2002

Examiner: M. Trinh

For: CARRIER FOR USED IN MANUFACTURING SEMICONDUCTOR  
ENCAPSULANT PACKAGES

Attorney Docket No.: U 013851-0

Commissioner for Patents  
P. O. Box 1450  
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REQUEST FOR NEW ACTION

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### REMARKS

A new Action is required, because the Action is on the wrong claims. On the one hand, the application was filed with claims 1-8, of which claims 4 and 5 were multiple dependent, but the Action is on claims 1-12. On the other hand, the Preliminary Amendment of February 15, 2002, added claims 9-12 as in the Action, but deleted the multiple dependence of claim 4, which is nevertheless objected to in the Action.

Therefore, the Action examined the wrong claims and must be re-issued with a new date.

Despite this problem of the Patent Office and the problem previously reported with the REQUEST FOR NEW ACTION of July 23, 2004, which the Patent Office has yet to act on, the Applicant nevertheless seeks to advance prosecution of the application.

The rejection under 35 USC 103 for obviousness from the BACKGROUND OF THE INVENTION section of applicant's specification (APA in the Action), overlooks the difficulty with the prior art described and, therefore, the criticality of the claimed difference, the obtuse angle  $\theta$ . Criticality overcomes any prima facie obviousness found in the Action.

The APA of the first prior art reference of FIG. 1 discloses a right or smaller, acute angle between the positioning pin 13 and the receiving part 12, and not the bigger than right, obtuse angle  $\theta$  claimed. The prior art reference FIG. 1 APA teaches smaller angles and not bigger, as claimed. Smaller is contrary to bigger. Therefore, APA FIG. 1 teaches away from the claimed invention and does not support the rejection.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. Denied, 469 U.S. 851 (1984) .... MPEP 2141.02 PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS, 2100-122, Rev. 1 Feb 2003 (emphasis original).

The APA of the second prior art reference of FIG. 2 discloses an arched positioning pin 23. However, the angle between the lower portion of the positioning pin 23 and the receiving part 22 is still an acute angle. Therefore APA FIG. 2 also teaches away from the claimed invention and does not support the rejection.

As compared to the first APA prior art reference FIG. 1, the contrary obtuse angle  $\theta$  of claim 1 overcomes the problems of glue leaking along the positioning pin 13 to the backside of the substrate 5 and the receiving part 12 despite the small available area of the substrate 5. Although the second APA prior art reference FIG. 2 can also overcome this problem of the first APA prior art reference FIG. 1 as described in the specification, in the manufacture of its carrier 2, there is difficulty in controlling conditions of forming the arched surface. Therefore, the claimed bigger obtuse angle  $\theta$  of claim 1 both broadens the available areas of the substrate and avoids glue leaking, which neither of the APA references can do.

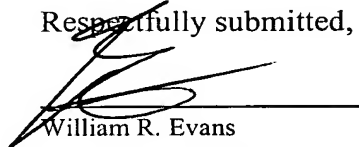
Moreover, the carrier of claim 1 is integrally formed and has advantage in being produced easily. Easier production is an advancement of the art, which patents are to foster, and

... there is no per se rule that making something in one piece that was formerly made in two or more pieces renders it obvious. Mooney v. Brunswick Corporation 206 USPQ 121 (E.D. Wis. DC 1980), aff'd. On other grounds 212 USPQ 401 (7<sup>th</sup> CA 1981).

Finally, even if first and second APA prior art references alone or with Banjo, et al. U.S. Patent 5,288,698, the application of which in the Action is not understood, together teach toward the whole claimed invention, there must be more than hindsight from the claimed invention to do this. There are only three possible motivations to combine references, "... the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998). None of these possible motivations is invoked for the rejection.

Reconsideration and allowance are, therefore, requested.

Respectfully submitted,



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